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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,249	04/25/2001	Kazuo Kuroda	Q64260	5288

7590 06/09/2005

SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

DINH, MINH

ART UNIT PAPER NUMBER

2132

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/841,249

Applicant(s)

KURODA ET AL

Examiner

Minh Dinh

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5,6,9,13 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,9,13 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/20/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment filed 03/29/2005. Claims 1, 5-6, 9 and 13 have been amended; claims 2-4, 7-8, 10-12 and 14-20 have been cancelled; claims 21-24 have been added.

### ***Response to Arguments***

2. Applicant's arguments with respect to claim 1 have been considered but are not persuasive. Applicant's amendments have necessitated a new search and new grounds of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5-6, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima et al. (EP 0 802 527 A1) in view of Bell ("The Dynamic Digital Disk). Regarding claim 1, which is representative of claims 5-6, 9 and 13, Oshima discloses an apparatus comprising:

a generating device for generating encryption information for use in encrypting record information to be recorded in a recordable information recording medium and in decrypting the encrypted record information to be recorded in the recordable information recording medium, the encryption information being recorded in the recordable information recording medium (figures 1 and 10);

an encrypting device for encrypting the record information by employing the encryption information (fig. 10); and

a distributing device for distributing the encrypted record information to an information recording/reproducing apparatus through a telecommunications line, wherein the information recording/reproducing apparatus records the encrypted record information in the recordable information recording medium in which the encryption information is recorded in advance (fig. 10).

Oshima does not disclose that the encryption information is encrypted by CSS (Content Scramble System) before it is recorded in the recording medium. Bell discloses that encryption information is encrypted by CSS before it is recorded in a recording medium (p. 32, middle column, 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Oshima apparatus such that the encryption information is encrypted by CSS before it is recorded in the recording medium, as taught by Bell, so that playback of the record information could only be done on compliant players.

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5. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima in view of Bell as applied to claims 1, 5, 9 and 13 above, and further in view of Parker ("Compatibility Counts"). Oshima discloses that the recording medium is a DVD-RAM disk (fig. 10). Oshima does not disclose using a DVD-RW disk. Parker discloses DVD-RW disks that can be reproduced by DVD-ROM drives, which meets the limitation of general DVD players (next to last paragraph). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined apparatus of Oshima and Bell such that the recording medium is a DVD-RW disk, as taught by Parker. DVD-RW disks can be read by regular DVD-ROM drives and no retrofitting will be necessary.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,532,201 to Hogan

U.S. Patent No. 6,556,679 to Kato et al.

Bloom et al, "Copy Protection for DVD Video"

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 571-272-3802. The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

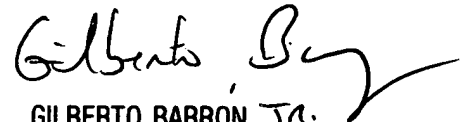
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MD

Minh Dinh  
Examiner  
Art Unit 2132

MD  
6/3/05

A handwritten signature in black ink, appearing to read "Gilberto Barron Jr.", with a stylized flourish extending from the end.

GILBERTO BARRON JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100